

REMARKS

I. Status Of The Claims

Claims 1-106 are pending in this application, of which all but claims 8, 9, 30-52, 55-59, 62, 64, 66, 68, 70, and 71 are withdrawn from consideration.

Claims 56-58 are rejected under 35 U.S.C. 112, second paragraph.

Claims 8, 9, 30-52, 55, 59, 62, 64, 66, 68, 70, and 71 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (U.S. Application No. 2001/0018739) in view of Ginter (U.S. Patent No. 6,427,140).

Claim 8 is independent.

II. Rejection Under 35 U.S.C. § 112

The Office Action rejects independent claims 56-58 under 35 U.S.C. 112, second paragraph, stating:

“[t]he independent claim discloses the transfer of electronic cash from one bank to another. Claims 56-58 disclose real-time access for official government research that is associated with econometric and law enforcement. The Applicant has not provided the motivation and/or logic how claims 56-58 depend from claim 8”
(see present Office Action, p. 3; emphasis added).

Applicants respectfully disagree with the rejection at least in view of the disclosure of the present application stating:

“[a]ccording to certain embodiments of the invention, clearing banks, or computers or certified officers thereof, would have the ability to access the contents of all vaults used in the system. In embodiments where this was not the case, the DRM-V software might need to alter the attributes

of the vault prior to transmission to the clearing bank to allow full or limited access by the clearing bank or members of the law enforcement or bank regulatory communities for on-line, real time research capabilities through the various system databases, such as the cleared transactions database or pending transaction database”
(see disclosure of the present application, p. 19 lines 17-23; emphasis added).

In view of at least the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. 112 be withdrawn.

III. Rejection Under 35 U.S.C. § 103(a)

The Office Action rejects independent claim 8 under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Ginter. Applicants respectfully disagree with the rejection.

Applicants disagree with the rejection, for example, as the two references, taken individually or in combination, fail to disclose, teach, or suggest all aspects of claim 8.

For instance, Anderson and Ginter, taken individually or in combination, fail to disclose, teach, or suggest at least:

“... a first entity transmitting to the first entity’s clearing bank a cash request electronic mail message, said message requesting that an electronic representation of cash be sent to a specified second entity; and

the first entity’s clearing bank transmitting ... an electronic mail message attachment to the second entity’s clearing bank”

as set forth in claim 8 (emphasis added).

The Office Action, arguing that Anderson discloses all aspects of claim 8 “except for a digital rights management vault containing said electronic representation of cash”,

apparently relies upon Anderson to provide the above-quoted aspects of the claim.

However, Anderson fails to disclose, teach, or suggest such functionality and instead states that:

“... payer 12 ... electronically sends the instrument 74 and the memorandum 66 via a public network 65 to the payee 14 [and] ... payee 14 electronically deposits, typically via a public network, the instrument 74 with the banking institution which maintains the payee’s account 78” (see Anderson [0175] lines 24-26 and [0176] lines 19-21).

Applicants believe it clear that such is not at all like that which is set forth in claim 8.

Applicants further disagree with the rejection, for example, in view of the fact that in order to establish a prima facie case of obviousness, “there must be some suggestion or motivation ... to modify the references or to combine reference teachings” (see MPEP 2142).

The Office Action argues that “it would have been obvious to one having skill in the art at the time the invention was made to utilize a VIDE content container/digital rights management container as taught by Ginter ‘140, since Ginter ‘140 states at Col. 22, lines 15-25 that such a modification would eliminate the constraints of having to use a few high level individual, pre-defined content provider increments” (emphasis added). Although the Office Action indicates “Col. 22, lines 15-25”, it appears that “Col. 22, lines 27-34” was intended.

The identified portion of Ginter discusses “support [for] dynamic user selection of information subsets of a VDE electronic information product” (see col. 22, lines 27-28). Ginter explains that such functionality includes support for “metering and usage control over a variety of increments ... that are selected ad hoc by a user” (see col. 22, lines 34-37), and that “[t]he user may, for example, select certain numbers of bytes of information from various portions of an

information product, such as a reference work, and copy them to disc in unencrypted form and be billed based on total number of bytes plus a surcharge on the number of ‘articles’ that provided the bytes” (see col. 23 lines 5-10).

Applicants believe it clear that mere discussion of a feature (e.g., support for user selection of information subsets) does not constitute a suggestion or motivation to modify references or to combine reference teachings.

Moreover, such support for user selection of information subsets is not relevant to the operations discussed by Anderson.

For at least these reasons, Applicants respectfully submit that the portion of Ginter identified by the Office Action fails to provide the “suggestion or motivation” required to establish a prima facie case of obviousness. Applicants further submit that no other portion of Ginter, nor any other cited reference, provides the required “suggestion or motivation”.

In view of at least the foregoing, Applicants respectfully submit that independent claim 8, and those claims that depend therefrom, are in condition for allowance.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance for which action is earnestly solicited.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Applicants note that the Office Action states that “[t]he claims presently pending are 8, 9, 30-52, 55-59, 62, 64, 66, 68, and 70-71”. However, as no claims have been canceled in this case, it is Applicants’ understanding that claims 1-106 are pending in this application, of

which all but elected claims 8, 9, 30-52, 55-59, 62, 64, 66, 68, 70, and 71 are withdrawn from consideration.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No.

3892-4002. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

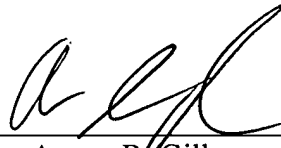
Furthermore, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account and Order No.

Respectfully submitted,

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